



Express Mail Label No.

Dated: \_\_\_\_\_

Docket No.: 20342/0202324-US0  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Nigel Atherton *et al.*

Allowed: November 2, 2005

Application No.: 09/891,206

Confirmation No.: 9337

Filed: June 26, 2001

Art Unit: 1616

For: Treatment of Bone Diseases

Examiner: John D. Pak

**REQUEST FOR PATENT TERM  
ADJUSTMENT UNDER 37 C.F.R. §§ 1.705(b)**

MS Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants, through the undersigned attorneys/agents, hereby request reconsideration of the Patent Term Adjustment ("PTA") indicated in the Notice of Allowance for this application. Applicants respectfully submit that the PTA indicated in the Notice of Allowance is incorrect, and that the correct Patent Term Adjustment to date (February 2, 2006) is actually **60 days**. A detailed statement of the facts involved is set forth below, starting on page 3 of this document, and pursuant to the requirements of 37 C.F.R. §§ 1.705(b)(2)(i) - (iv).

The Issue Fee Transmittal and amendment under 37 C.F.R. §1.312 for this patent application accompany this submission, along with a check in the amount of **\$1,900.00** for payment of (i) the Issue and Publication Fees (\$1,700.00); and (ii) the \$200.00 fee required under 37 C.F.R. §§ 1.705(b)(1) and 1.18(e). A copy of the following document is also attached hereto, for the Examiner's convenience when considering this request:

02/07/2006 WABDEL3 00000045 09891206 200.00 DP  
03 FC:1455

Tab A: the USPTO's Patent Term Adjustment ("PTA") History for this application, as downloaded from the Patent Application Information Retrieval (PAIR) WEB site on February 1, 2006;

It is believed that no additional fee is required for this submission. However, should the U.S. Patent and Trademark Office determine that any additional fee is required or that a refund is due for this application, then the Commissioner is hereby authorized and requested to charge the required fee(s) and/or credit any refund(s) due to the above-mentioned Deposit Account No. 04-0100.

## **STATEMENT OF THE FACTS INVOLVED**

### **A. Statement of the Correct Patent Term Adjustment (37 C.F.R. § 1.705(b)(2)(i))**

On November 2, 2005, the U.S. Patent and Trademark Office mailed a Notice of Allowance for this application stating that “[t]he Patent Term Adjustment to date [November 2, 2005] is 0 day(s).” The Notice of Allowance also states that:

If the issue fee is paid on the date that is three months after the mailing date of this notice [*i.e.*, on February 2, 2006] and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice [*i.e.*, on May 16, 2006], the Patent Term Adjustment will be 0 days.

The detailed Patent Term Adjustment History calculated by the U.S. Patent and Trademark Office for this application (hereinafter referred to as the “PTA History”)<sup>1</sup> is attached hereto at Tab A, and reveals that the Patent and Trademark Office calculated a patent term adjustment of 37 days for “USPTO delay,” reduced by 213 days for “applicant delay.”

The U.S. Patent and Trademark Office’s calculation of the Patent Term Adjustment is incorrect, as explained in detail below. The correct Patent Term Adjustment to date (February 2, 2006) is **60 days**. Applicants assert that the correct amount of Patent Term Adjustment is the difference between the sum of the periods calculated under 37 C.F.R. § 1.703(a)-(e) (*i.e.*, **342 days**) less the sum of the periods calculated under 37 C.F.R. § 1.704 (*i.e.*, **282 days**). *See*, 37 C.F.R. § 1.703(f).

### **B. Bases under 37 C.F.R. §1.702 for the Adjustment and The Relevant Dates For Which an Adjustment Is Sought (37 C.F.R. §§ 1.705(b)(2)(i) and (ii))**

Applicants assert the following bases under 37 C.F.R. §1.702 for the adjustment and the relevant dates for which an adjustment is sought under 37 C.F.R. §1.703(a)-(e):

---

<sup>1</sup> The PTA History was downloaded from the Patent Application Information Retrieval (PAIR) WEB site on February 1, 2006.



**C. Statement Regarding Terminal Disclaimer  
(37 C.F.R. 1.705(b)(2)(iii))**

This application is not subject to any terminal disclaimer.

**D. Statement of Circumstances Constituting a Failure to Engage in Reasonable Efforts to Conclude Prosecution (37 C.F.R. § 1.705(b)(2)(iv))**

Applicants assert that the following reductions apply to the period of adjustment of patent term under 37 C.F.R. § 1.704:

(1) Under 37 C.F.R. § 1.704(b) and as revealed by the PTA History, the 3-month extension of time requested in response to the Office Action mailed January 29, 2003 (91 days); the 3-month extension of time requested in response to the Office Action mailed October 21, 2003 (91 days); and the 1-month extension of time requested in response to the Office Action mailed July 12, 2004 (31 days), are failures to engage in reasonable efforts to conclude prosecution. The sum of these extensions is **213 days** ( $91 + 91 + 31 = 213$  days).

(2) Under 37 C.F.R. § 1.704(c)(10), submission of a paper after a Notice of Allowance has been mailed are failures to engage in reasonable efforts to conclude prosecution. The period of adjustment set forth under 37 C.F.R. § 1.703 shall be reduced by the lesser of the number of days beginning on the date a paper (such as an amendment under 37 C.F.R. § 1.312) was filed and ending on the mailing date of the Office Action (or notice in response to the amendment under 37 C.F.R. § 1.312) or 4 months. Thus, under 37 C.F.R. § 1.704(c)(10), the period between submission of a Request for Continued Examination on April 27, 2005 (*i.e.*, after the Notice of Allowance was mailed) and the mailing of the next Office Action (*i.e.*, July 5, 2005) is a failure to engage in reasonable efforts to conclude prosecution. This period (April 27, 2005 to July 5, 2005) is **69 days**.

(3) According to the PTA History, an “Amendment After Notice of Allowance (Rule 312)” was filed on June 9, 2005 and a “Response to Amendment Under Rule 312” was mailed on June 29, 2005. Under 37 C.F.R. § 1.704(c)(10) as summarized above in (2), the period of adjustment set forth under 37 C.F.R. § 1.703 shall be reduced by the lesser of the number of days beginning on the date an amendment under 37 C.F.R. § 1.312 was filed and ending on the mailing

date of the notice in response to the amendment under 37 C.F.R. § 1.312 or 4 months. Applicants respectfully submit that 37 C.F.R. § 1.704(c)(10) does not apply in the instant case because a Request for Continued Examination was filed on April 27, 2005 (*i.e.*, before the “Amendment After Notice of Allowance (Rule 312)” on June 9, 2005 was filed.) Thus, classification of the June 9<sup>th</sup> amendment as an amendment after Notice of Allowance is incorrect. In sum, for the purposes of calculating delays under 37 C.F.R. § 1.704(c)(10), Applicants assert that the “Amendment after Notice of Allowance (Rule 312)” of June 9, 2005 in the PTA History is not an amendment under 37 C.F.R. §1.312 because a Request for Continued Examination was filed on April 27, 2005 and should not be considered a failure to engage in reasonable efforts to conclude prosecution.

## Conclusion

Respectfully submitted,

By Shelly M. Fuchikawa  
Shelly M. Fuchikawa, Ph.D. (Reg. No. 56,190)  
DARBY & DARBY P.C.  
P.O. Box 5257  
New York, New York 10150-5257  
(212) 527-7700  
(212) 753-6237 (Fax)  
Attorneys/Agents For Applicant

**Attachments:**

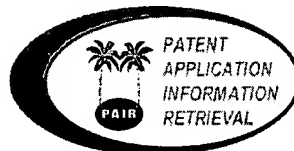
Tab A: USPTO's Patent Term Adjustment ("PTA") History, as downloaded from the Patent Application Information Retrieval (PAIR) WEB site on February 2, 2006;



# United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

## PATENT APPLICATION INFORMATION RETRIEVAL



### Patent Term Adjustment (PTA) for publication number: 09/891,206

			Days
Filing or 371(c) Date:	06-26-2001	USPTO Delay (PTO):	37
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	213
Post-Issue Petitions (days):	+0	Total PTA:	0
USPTO Adjustment (days):	+0	Explanation of Calculations	

#### Search Options

Assignments
Display References
Foreign Priority
Image File Wrapper
File History
Publication Review
Published Documents

### Patent Term Adjustment History

Date	Contents Description	PTO (days)	APPL (days)
11-02-2005	Mail Notice of Allowance		
11-01-2005	Notice of Allowance Data Verification Completed		
10-05-2005	Information Disclosure Statement (IDS) Filed		
10-28-2005	Date Forwarded to Examiner		
10-05-2005	Response after Non-Final Action		
07-05-2005	Mail Non-Final Rejection		
07-01-2005	Non-Final Rejection		
06-29-2005	Date Forwarded to Examiner		
06-29-2005	Date Forwarded to Examiner		
04-27-2005	Request for Continued Examination (RCE)		
06-29-2005	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
04-27-2005	Miscellaneous Incoming Letter		
06-29-2005	Mail Acknowledgement of Priority Papers		
06-29-2005	Acknowledgement of Priority Papers		
04-27-2005	Request for Foreign Priority (Priority Papers May Be Included)		
06-29-2005	Mail Response to 312 Amendment (PTO-271)		
06-29-2005	Response to Amendment under Rule 312		
06-09-2005	Amendment after Notice of Allowance (Rule 312)		
06-29-2005	Correspondence Address Change		
06-29-2005	Change in Power of Attorney (May Include Associate		



	POA)		
04-27-2005	Workflow - Request for RCE - Finish		
06-17-2005	Receipt into Pubs		
05-26-2005	Workflow - Query Request - Finish		
05-16-2005	Workflow - Query Request - Begin		
04-27-2005	Workflow - Request for RCE - Begin		
02-17-2005	Workflow - File Sent to Contractor		
01-31-2005	Mail Notice of Allowance		
01-31-2005	Mail Examiner's Amendment		
01-28-2005	Notice of Allowance Data Verification Completed		
01-28-2005	Case Docketed to Examiner in GAU		
01-28-2005	Examiner's Amendment Communication		
12-08-2004	Date Forwarded to Examiner		
11-12-2004	Response after Non-Final Action		31
11-12-2004	Request for Extension of Time - Granted		↑
11-12-2004	Workflow incoming amendment IFW		↑
07-12-2004	Mail Non-Final Rejection		↑
07-09-2004	Non-Final Rejection		
05-04-2004	Date Forwarded to Examiner		
04-21-2004	Response after Non-Final Action		91
04-21-2004	Request for Extension of Time - Granted		↑
11-16-2001	Oath or Declaration Filed (Including Supplemental)		↑
04-21-2004	Workflow incoming amendment IFW		↑
10-21-2003	Mail Non-Final Rejection		↑
10-20-2003	Non-Final Rejection		
08-11-2003	Date Forwarded to Examiner		
07-29-2003	Response after Non-Final Action		91
07-29-2003	Request for Extension of Time - Granted		↑
01-29-2003	Mail Non-Final Rejection		↑
01-27-2003	Non-Final Rejection		
11-21-2002	Date Forwarded to Examiner		
11-04-2002	Response to Election / Restriction Filed		
10-02-2002	Mail Restriction Requirement	37	
10-01-2002	Requirement for Restriction / Election	↑	
07-10-2002	Information Disclosure Statement (IDS) Filed	↑	
05-09-2002	Information Disclosure Statement (IDS) Filed	↑	
02-27-2002	Case Docketed to Examiner in GAU	↑	
06-26-2001	Preliminary Amendment	↑	
11-28-2001	Application Dispatched from OIPE	↑	
11-27-2001	Application Is Now Complete	↑	
08-22-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	
08-21-2001	Correspondence Address Change	↑	
07-05-2001	IFW Scan & PACR Auto Security Review	↑	
06-26-2001	Initial Exam Team nn	↑	